

REMARKS

Claims 1-10 are pending. As a result of this amendment, claims 1, 2, 4, 7, 9 and 10 have been amended. No new matter has been entered into this application by way of amendment. Applicants request rejoinder of claim 10 drawn to method of treatment upon a determination of allowable compounds claims.

I. The Nonstatutory Double Patent Rejection:

Claims 1-9 in-part have been rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-19 of U.S. Patent 6,420,364 (referred to hereafter as the '364 patent). This rejection is traversed for the following reasons.

The '364 patent neither teaches nor suggests, alone or in combination with any other prior art, Applicants' compounds and methods. Applicants contend that a prima facie case of structural obviousness for all compounds in the claims has not been made out. However, solely to further prosecution in the case, enclosed herewith is the declaration of Erick Young. The Declaration presents evidence of unexpected results in Cathepsin S activity observed for the claimed compounds where the center of the core structure (referred to "R" in the declaration) provides applicants unique branched alkyl chain vs. the R groups of the prior art. The declaration accordingly provides a direct comparison of the Cathepsin S activity of several particularly branched alkyl compounds versus the alkyl groups of the closest prior art compounds. The data reports the Ki unexpectedly improved selectivity profile of these inhibitors for cathepsin S over its closely related family member cathepsin L. Exhibit A submitted herewith contains literature references mentioned in the declaration which detail why such selectivity is desirable. Accordingly, the claimed invention is believed to be unobvious from the prior art of record, and accordingly withdrawal of the rejection under 35 USC § 103 is respectfully requested.

Claim Objections

Applicants have cancelled non-elected subject matter thereby rendering such objection moot.

Respectfully submitted,

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